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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/789,245

02/27/2004

John E. McAlvin

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49840 7590 02/02/2007

BAKER, DONELSON, BEARMAN, CALDWELL & BERKOWITZ
SUITE 3100 SIX CONCOURSE PARKWAY
ATLANTA, GA 30328

EXAMINER

NUTTER, NATHAN M

ART UNIT

PAPER NUMBER

i711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/789,245

Applicant(s)

MCALVIN ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-21 and 25 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claim 26 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim recites a "gel coat" which is distinct from a polymer composition, per se. The coated substrates are classified in Class 428. The inventions are related as an intermediate-final product situation. The intermediate is deemed useful as a molding or extrusion product.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 26 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

This application contains claims 22-24 and 26 drawn to inventions nonelected with traverse in the paper filed 13 January 2006, and as being non-elected by original presentation, herein. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Interpretations

The recitation in claim 11 of "wherein the unsaturated polyester has an acid number of less than about 50" is deemed to be inherent in the unsaturated polyester broadly disclosed since the claims fail to recite any parameters that might be deemed to affect the particular acid number. Since there is no guidance, it is assumed that any

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unsaturated polyester usable in a coating composition, as recited in the broad claim would possess the acid number of less than 50.

The recitations in each of claims 17, 18, 19 and 20 of "up to about 10 percent by weight (claim 17)," "up to about 40 percent by weight (claim 18)," "up to about 5 percent by weight (claim 19)" and "up to about 10 percent by weight (claim 20)" do not require the presence of either constituent. As such, any reference cited against the broad claim 1 would embrace the recitations of each of claims 17 through 20 since those constituents are not required.

Response to Amendment

In response to the amendment, the following is placed in effect.

The rejection of claim 7, only, under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, is hereby expressly withdrawn.

The rejection of claims 1-9, 11-21 and 25, only, under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby expressly withdrawn.

The rejection of claims 1-21 and 25 under 35 U.S.C. 102(e) as being anticipated by Hewitt et al (US 2004/0010061 A1), is hereby expressly withdrawn.

The rejection of claims 1-11, 14-21 and 25 under 35 U.S.C. 103(a) as being unpatentable over Jaworek et al (US 6,777,458), is hereby expressly withdrawn.

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The rejection of claims 1-21 and 25 under 35 U.S.C. 103(a) as being unpatentable over Jaworek et al (US 6,777,458) in view of Kosono et al (US 6,992,140), is hereby expressly withdrawn.

Claim Objections

Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. The recitation of claim 15 of "up to about 30 percent by weight," which has a lower limit of "0 % by weight" is deemed to be broader than claim 14 from which it depends.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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In claim 10, the recitation of "analogues of such monomers" is not proper since analogues are compounds having similar electronic structures but different atoms. An analogue may change the nature of a composition completely due to the different elements that may be employed. To determine what analogues might be usable, without interfering with the proposed use of the composition, would require the undue burden of experimentation. Since analogues differ in elemental composition, they would possess properties that may or may not be usable in the present application, and would require the undue burden of experimentation to determine. This is deemed true especially in view of valences of species, nitrogen for example, or for groups that may materially affect the basic and novel characteristics of a composition, including groups such as azide, sulfonyl, hydrazide, etc..

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, the recitation of "analogues of such monomers" is not proper since analogues are compounds having similar electronic structures but different atoms. An analogue may change the nature of a composition completely due to the different elements that may be employed. As such, the proper metes and bounds of the claims

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cannot be clearly and easily discerned. Since analogues may vary so broadly, it is not clear as to what the claim limitations actually are with regard to its metes and bounds.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/440,610. Although the conflicting claims are not identical, they are not patentably distinct from each other because the particular unsaturated polyester of the copending application is embraced by the recitations in the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 16-21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boeckeler et al (US 5,369,139).

The patent to Boeckeler et al (US 5,369,139) teach the manufacture of a free radical curable resin composition that may comprise urethane (meth)acrylates and unsaturated polyesters. Note column 2 (lines 21-68) and Examples 1 and 3 at columns 5 and 6. The examples show the combination of oligomers. The urethane (meth)acrylates may be the product of a diisocyanate and an hydroxyl-functionalized (meth)acrylate monomer (claim 4). Aliphatic isocyanates may be employed at column 2 (lines 62-68) as recited in claim 16. Reactive monomers, including multifunctional (meth)acrylates and hydroxyl functional (meth)acrylates (claims 7 and 10) in combination of "one or more," are taught for inclusion at up to 30 weight percent (within the range specified for both in claims 6 and 8 at a minimum of 10 weight percent for

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both). The recitations in each of claims 17-20 do not require the presence of either constituent. As such, those claims are all deemed to be met by the reference.

The reference is silent with respect to the compositional limitations for each of the constituents separately. Examples 1 and 3 show a 50:50 ratio of unsaturated polyester and urethane (meth)acrylate. However, if "up to 30 weight percent" diluent reactive monomers are added, the overall weight percent for these constituents will lower to be within the combined weight percents for claims 5 and 9. A skilled artisan would know how to manipulate the constituents for desired effects, resin availability, etc.. As such, the instant claims are deemed to be obvious over the teachings of the reference.

Response to Arguments

Applicant's arguments filed 11 December 2006 have been fully considered but they are not persuasive.

With regard to the provisional rejection of claims 1-21 and 25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/440,610, there has been no timely filed Terminal Disclaimer.

With regard to the rejection of claims 1-11, 16-21 and 25 under 35 U.S.C. 103(a) as being unpatentable over Boeckeler et al (US 5,369,139), the presence of water has not been shown by applicants to materially affect the basic and novel characteristics of the composition. This is supported by applicants at page 17 first full paragraph of the response of 11 december 2006, wherein it is stated "(t)he less water which is present,

the more quickly it can be removed from the deposited film." Thus, the basic and novel characteristics have not been shown to be materially affected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

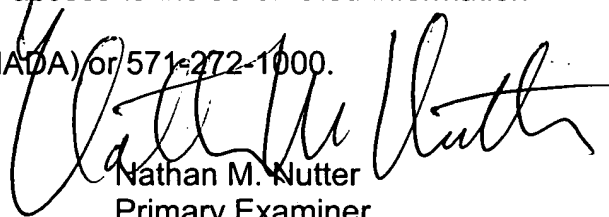
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

31 January 2007